

Oral Hearing:
February 19, 2002

Paper No. 19
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Savin Corporation

Serial No. 75/565,398

David A. Einhorn and James M. Andriola of Anderson Kill & Olick,
P.C. for Savin Corporation.

Ronald E. Aikens, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Quinn, Hohein and Botorff, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Savin Corporation has filed an application to register the mark "SAVIN NET" for "computer software system for processing parts and supplies orders via a real-time on-line system, namely software generating a graphical user interface that is downloadable by customers for use in communicating with the vendor" in International Class 9 and "computerized on-line ordering services in the field of office machinery and equipment" in International Class 35.¹

¹ Ser. No. 75/565,398, filed on October 7, 1998, based upon an allegation of a bona fide intention to use such mark in commerce. By an amendment to allege use, received on February 23, 2001, the application was amended to claim a date of first use anywhere and in commerce of October 1, 1998 for both the goods and the services.

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant's refusal to comply with a requirement for a disclaimer of the term "NET," which the Examining Attorney maintains means "network" and as such is merely descriptive of applicant's goods and services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

Applicant has appealed. Briefs have been filed and an oral hearing was held. We affirm the disclaimer requirement.

Applicant contends that the term "NET" is not merely descriptive of its goods and services and thus does not constitute an unregistrable component of its "SAVIN NET" mark which must be disclaimed. By way of background, applicant asserts in its initial brief that it "sells its products and services through 17 company-owned branches and over 750 trained dealers throughout the United States." Although admitting, in such brief, that its description of goods and services in the present application "describes a real-time on-line system that uses modems and telephone lines" for placing parts and supplies orders, applicant insists that "that system is different from other global computer networks." Consequently, applicant urges that its "SAVIN NET" mark, "in referring to a computer system that links computers through modems and telephone lines[,] does not refer to a global computer network." In addition, applicant argues that its mark "refers to services involving a real-time on-line connection only between Applicant and Applicant's

customers" and thus such mark "does not refer to the Internet or any other global computer network."

Furthermore, according to applicant's initial brief:

Not only is the Examiner inaccurate when he holds that the word "NET" as used by Applicant is descriptive of a "network of computers," the Examiner also fails to address the suggestive quality of the mark SAVIN NET as applied to the goods and services identified in the application. The goods and services offered under this mark are designed to provide authorized Savin dealers, as well as Savin customers, a means of quickly replacing parts when they fail. In this sense, SAVIN NET has a strong suggestive quality in that it implies a "safety net" for Savin's customers.

Applicant also contends, in such brief, that "[e]ven if the term 'NET' as used herein is held to be merely descriptive, the merely descriptive significance of the term 'NET' is lost in the mark as a whole" because "[t]he proximity of the two 'N's in SAVIN NET give it a 'cadence which encourages persons encountering it to perceive it as a whole,'" citing *In re Kraft, Inc.*, 218 USPQ 571, 573 (TTAB 1983) [disclaimer of "LIGHT" not required for mark "LIGHT N' LIVELY" for reduced calorie mayonnaise]. Additionally, in its supplemental brief, applicant asserts that its "SAVIN NET" mark is suggestive because it "sounds like 'SAVIN(G) IT'" and, in such sense, "it conveys to the customer that there are good deals to be found on-line for Savin equipment."

Finally, applicant submits in its initial brief that a disclaimer of the term "NET" is inappropriate because, as evidenced by the copies which it has made of record, none of the nine third-party registrations for marks which include such term

for goods and/or services which are explicitly recited as involving a "computer network" contains a disclaimer of the term "NET." Fairness, applicant maintains, dictates that inasmuch as "the Trademark Office has permitted registration of the term 'NET' without a disclaimer when the description of goods [and/or services] actually contains the terms 'computer network,' the present application, which does not contain the terms 'computer network,' should surely be allowed without a disclaimer."

The Examining Attorney, on the other hand, contends that the term "NET" in applicant's "SAVIN NET" mark "is merely descriptive of applicant's goods and services because it "immediately conveys how the Applicant's goods work and precisely what is being offered by and through the Applicant's goods and services and, therefore, clearly describes a significant characteristic and feature, as well as the function and purpose, of the relevant goods or services." Consequently, and since the Examining Attorney also finds that such mark is not unitary, the Examining Attorney maintains that applicant's mark "is not registrable on the Principal Register without a disclaimer of the descriptive wording."

Specifically, the Examining Attorney argues that "the word 'NET,' used in relation to goods and services for use in real-time, on-line communications with vendors, immediately would convey to the purchaser the information that the Applicant's goods create a computer or telecommunications network and connect the user to that same computer or telecommunications network." In support thereof, the Examining Attorney has made of record

from various dictionaries, encyclopedias and websites definitions of the terms "net" and "network," including the following:

"net," which is set forth as meaning:
(i) "A network; for example, a network of computers connected to each other" by the High Tech Dictionary; (ii) "Abbreviation of network. 'The Net' generally refers to the Internet" in the Tech Encyclopedia; and (iii) "Computer Science. See network" by The American Heritage Dictionary of the English Language (3d ed. 1992); and

"network," which is defined as: (i) "(1) A system that transmits any combination of voice, video and/or data between users" in the Tech Encyclopedia; (ii) "A group of two or more computer systems linked together. There are many types of computer networks including ... wide area networks (WANs): The computers are farther apart [than local area networks] and are connected by telephone lines or radio waves" by Webopedia; (iii) "Two or more computers that are connected. The most common types of networks are: ... WAN - wide area network: The computers are at different geographical locations and are connected by telephone lines or radio waves" in NetLingo; and (iv) "4. ... b. Computer Science. A system of computers interconnected by telephone wires or other means in order to share information. Also called net" by The American Heritage Dictionary of the English Language (3d ed. 1992).

Also of record, from The American Heritage Dictionary of the English Language (3d ed. 1992), is a definition of the term "on-line," which appears in the identification of applicant's goods and the recitation of its services, as meaning "1. Computer Science. b. Connected to a computer network. c. Accessible via a computer or computer network: an on-line database."

With respect to applicant's contention that the term "NET" in its mark refers to the use of its goods and services to place parts and supplies orders via a modem over telephone lines rather than a global computer network, the Examining Attorney notes that the brochure which applicant made of record concerning its goods and services, entitled "Put Your Processing On-line With Savin Net," clearly states that "Savin Net is an ON-LINE processing system" which is designed to allow users to "[c]ommunicate with ANYONE in the Savin Net network through the E-MAIL function" and to "[s]hare information with other dealers and communicate directly with your Savin Dealer Regional Office." Thus, while not disputing applicant's assertion that the term "NET" in its mark refers to the placement of orders on-line via a modem over telephone lines and not through a global computer network such as the Internet, the Examining Attorney "contends that the Applicant's own use of the word 'NET' falls within the scope of the ... definitions of the words 'NET' and 'NETWORK'" Accordingly, the Examining Attorney concludes that:

The plain meaning of the word "NET," in the context of the Applicant's goods and services[,] is "NETWORK." The word "Network" is [merely] descriptive of a system of computers interconnected by telephone wires or other means--a system that transmits any combination of voice, video, and/or data between users--in order to share information. The addition of the word "SAVIN" in front of the word "NET" does not change the meaning of the word "NET."

As to applicant's argument that, even if merely descriptive, a disclaimer of the term "NET" is not required because its "SAVIN NET" mark is unitary, the Examining Attorney

observes that the elements of such mark are not so merged together that they cannot be regarded as separable.² In particular, the Examining Attorney maintains that, unlike the mark "LIGHT N'LIVELY" in *In re Kraft*, supra, "the proximity of the two 'N's' in the words comprising the Applicant's ... mark do not create a cadence that encourages persons to view the ... mark as a whole." Instead, the Examining Attorney states that those encountering applicant's "SAVIN NET" mark "will merely see the word 'NET' as an abbreviation of the word 'NETWORK,' and as a reference to the purpose and function and a feature of the Applicant's goods and services." According to the Examining Attorney, "[no] alliteration is created by the combination of the words 'SAVIN' and 'NET,' nor [is there] a slurring of the words such that 'SAVIN NET' sounds like 'SAVING IT,' ... nor [is there] any other similar cadence [which] is created such that consumers would find that the combination of the words is so inseparable ... [as constituting] a source indicator for the applicant's goods and services."

Concerning the third-party registrations submitted by applicant, the Examining Attorney insists that they do not

² Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), provides in relevant part that an applicant may be required "to disclaim an unregistrable component of a mark otherwise registrable." As explained in *Dena Corp. v. Belvedere Int'l Inc.*, 950 F.2d 1555, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991):

A unitary mark simply has no "unregistrable component," but is instead an inseparable whole. A unitary mark cannot be separated into registrable and nonregistrable parts. Because unitary marks do not fit within the language of section 1056(a), the ... [Examining Attorney] cannot require a disclaimer.

"suggest either that the Applicant's ... mark is unitary or that the Office has begun refraining from requiring disclaimers of the word 'NET.'" While correctly pointing out, as set forth in *In re Scholastic Testing Service, Inc.*, 196 USPQ 517, 519 (TTAB 1977), that each case must be considered on its own merits³ and that a mark which is merely descriptive is not made registrable simply because the register already contains a similar mark or marks, the Examining Attorney notes that he has introduced numerous third-party registrations, some of which issued as recently as a year ago, in which "the Office has required disclaimers of the word 'NET'" for goods and services involving computers, computer networks and/or on-line applications. "More significantly," as the Examining Attorney accurately observes, the third-party registrations furnished by applicant "actually tend to support the Examining Attorney's position" because, in almost every instance, they "are consistent with past and current practices of not requiring disclaimers in slogans or telescoped marks."

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it forthwith conveys an immediate idea of any ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987)

³ See, e.g., *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's] application, the ... allowance of such prior registrations does not bind the Board or this court."]; *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1514 (TTAB 2001); and *In re Pennzoil Products Co.*, 20 USPQ2d 1753, 1758 (TTAB 1991).

and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Thus, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

We agree with the Examining Attorney that requiring a disclaimer of the term "NET," which in the context of applicant's goods and services plainly signifies "NETWORK," is proper because such term is merely descriptive of such goods and services for on-line use and is not an inseparable part of the mark "SAVIN NET" as a whole. In particular, we find that the term "NET" immediately describes, without conjecture or speculation, a significant characteristic or feature, as well as a function or purpose, of applicant's computer software for a real-time on-line system for processing parts and supplies orders by its customers and its associated computerized on-line ordering services in the

field of office machinery and equipment. Such term conveys forthwith that, as identified in its application, applicant's goods and services are net- or network-based, in that they are connected to or accessible by a computer network, irrespective of whether such network is a global one, like the Internet, or is actually a private network, like that created by the computer software system offered by applicant, which links its customers through the use of modems and telephone lines for purposes of processing parts and supplies orders.

Applicant's brochure, as noted previously, clearly states that "Savin Net is an ON-LINE processing system" and that the goods and services to be provided under its "SAVIN NET" mark are designed to allow users to "[c]ommunicate with ANYONE in the Savin Net network through the E-MAIL function" and to "[s]hare information with other dealers and communicate directly with your Savin Dealer Regional Office." Such a system for the transfer or transmission of data and other information between computers, which applicant acknowledges in the case of its goods and services is done via modems through the use of telephone lines so as to interconnect its customers to applicant and each other, plainly meets the definitions of "net" and "network" which are of record. Therefore, consistent with virtually all of the third-party registrations made of record by both applicant and the Examining Attorney, a disclaimer of "NET" is indeed proper unless the mark "SAVIN NET" is a unitary mark.

Contrary to applicant's arguments, the term "NET" is not an inseparable part of the mark "SAVIN NET" viewed as a

whole. Specifically, we agree with the Examining Attorney that the alliteration created by the proximity of the double letters "N" in the terms comprising applicant's mark is too pronounced, rather than too subtle, to create a cadence that encourages customers to regard the mark as an inseparable whole. The combination of the terms "SAVIN" and "NET" does not result in a separate and distinct meaning which is independent of the meaning of the constituent elements or project a single and distinct commercial impression. Such elements are simply not so merged together that they cannot be regarded as separate. There thus is no slurring which would suggest "SAVING IT," nor would a "safety net" come readily to a customer's mind. Instead, in the context of applicant's goods and services, customers would view the mark "SAVIN NET" as connoting a network for dealers in and retailers of Savin office machinery and equipment. While applicant also uses a variant of its "SAVIN NET" mark in which the two letters "N" overlap so as to give the impression of a single integrated term, the specimens of use plainly demonstrate that applicant utilizes the mark it seeks to register in the same format as shown on the drawing, that is, as the two separate terms "SAVIN NET." In view thereof, we concur with the Examining Attorney that the mark "SAVIN NET" is not unitary.⁴ Absent a disclaimer

⁴ See, e.g., *Dena Corp. v. Belvedere Int'l Inc.*, supra at 1052 [mark consisting of the words "EUROPEAN FORMULA" depicted above a circular design on a dark square or background for cosmetics held not unitary]; *In re Lean Line, Inc.*, 229 USPQ 781, 782-83 (TTAB 1986) [mark "LEAN LINE" for low calorie foods found not unitary; requirement for disclaimer of "LEAN" held proper]; *In re IBP, Inc.*, 228 USPQ 303, 304 (TTAB 1985) [mark "IBP SELECT TRIM" for pork held not unitary; refusal of registration affirmed in absence of a disclaimer of "SELECT TRIM"]; *In re Uniroyal, Inc.*, 215 USPQ 716, 719 (TTAB 1982) [mark "UNIROYAL

of the merely descriptive term "NET," such mark is accordingly not registrable.

Decision: The requirement for a disclaimer under Section 6(a) is affirmed. Nevertheless, in accordance with Trademark Rule 2.142(g), this decision will be set aside and applicant's mark will be published for opposition if applicant, no later than thirty days from the mailing date hereof, submits an appropriate disclaimer of the merely descriptive term "NET".⁵

STEEL/GLAS" for vehicle tires found not unitary; requirement for disclaimer of "STEEL/GLAS" held appropriate]; and In re EBS Data Processing, Inc., 212 USPQ 964, 966 (TTAB 1981) [mark "PHACTS POCKET PROFILE" for personal medication history summary and record forms held not unitary; refusal to register affirmed in absence of a disclaimer of "POCKET PROFILE"]].

⁵ See In re Interco Inc., 29 USPQ2d 2037, 2039 (TTAB 1993). For the proper format for a disclaimer, attention is directed to TMEP §§1213.09(a)(i) and 1213.09(b).